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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,981	03/22/2001	Herbert Ulrich	879.154USWO	9996
23552	7590	03/18/2004		
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER DEL SOLE, JOSEPH S	
			ART UNIT 1722	PAPER NUMBER

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/787,981	Applicant(s) ULRICH ET AL.	
	Examiner Joseph S. Del Sole	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003 and 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7-13 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 7, newly amended 10/27/03, recites the limitation "the lamellae being individually adjustable relative to the outer surface of the pipe without altering a radial position of the other lamellae". In so much as this limitation is interpreted to mean that each lamellae is adjustable without altering the position of any other lamellae, such subject matter was not described in the specification. Figure 3 shows that there is not one motor, 45, for each lamellae 40; the specification does not convey otherwise. At lines 19-26 of page 4 the specification describes problem free adjustment of individual lamellae with respect to either the lamellae of the following or preceding rings. Since the original disclosure does not describe the individual lamellae's adjustment with respect to the lamellae of its own ring, there is no support for the newly added claim and is new matter.

Claim 15, newly added 10/27/03, recites the limitation "the third lamellae ring being located at a third position along the longitudinal axis of the pip adjacent to the second lamellae ring, the lamellae of the first, second and third lamellae rings interlocking in a continuous mesh along the longitudinal axis of the calibrating station whereby the inner diameter of the first, second and third lamellae ring define an inner tubular core sized to receive the extruded plastic pipe". In so much as this limitation is interpreted to mean that the third lamellae ring is located at a third position that is different than the first position of the first lamellae ring, such subject matter was not described in the specification; a first and third ring cannot intermesh if they are at the same longitudinal location and thus the intermeshing property is new matter. Figure 2 shows two rings forming an inner tubular core, the rings being #s 42 and #43; the specification does not convey otherwise. Since the original disclosure does not describe a third lamellae ring located at a third position different from the first position of the first lamellae ring, there is no support for the newly added claim and is new matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Schott, Jr. (3,980,418).

Schott, Jr. teaches a device for producing an extruded plastic pipe (Fig 1, #14) having a longitudinal axis and an outer surface defining an outer diameter, the device having a calibrating station (Fig 1, #18) having at least first, second and third lamellae rings (Fig 1, A, B and C) each including a plurality of lamellae (Fig 1, #20) aligned circumferentially thereby defining an inner diameter for each of the first, second and third lamellae rings (Fig 2), the first, second and third lamellae rings each further including a plurality of adjustment arms (Fig 2, #s 30, 32 and 40), each adjustment arm begin secured to separate lamellae (Fig 2), the first lamellae ring being located at a first position along the longitudinal axis of the pipe, the second lamellae ring being located at a second position along the longitudinal axis of the pipe adjacent to the first lamellae ring, and the third lamellae ring being located at a third position along the longitudinal axis of the pipe adjacent to the second lamellae ring, the lamella of the first, second and third lamellae rings interlocking in a continuous mesh along the longitudinal axis of the calibrating station whereby the inner diameter of the first, second and third lamellae rings define an inner tubular core sized to receive the extruded plastic pipe (Fig 2); wherein contact between the outer surface of the pipe and the inner tubular core of the calibrating station adjusts the outer diameter of the pipe.

Response to Arguments

5. Applicant's arguments with respect to claims 7-15 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant's amendments to claims 7-13 have overcome the rejection over Schott, Jr. and the claims are allowable over the prior art, however the claims contain

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new matter and are thus not allowed. Amending the claims to correct the new matter may result in non-allowability of the claims.

The Applicant argues that new claim 15 is not disclosed by Schott.

The Examiner disagrees. The three rings as taught by the Applicant include two rings that don't intermesh but are only at different positions longitudinally (Figs 2 and 3). Therefore, the identical rings of Schott, Jr. intermesh in the same way that the first and third rings of the Applicant's invention. However, in so much as the claim is interpreted that the three rings are at different positions, this limitation is new matter as discussed above.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph S. Del Sole whose telephone number is (571) 272-1130. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

Joseph S. Del Sole

J.S.D.

March 12, 2004